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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ASUSTEK COMPUTER INC. and
ASUS COMPUTER INTERNATIONAL,

Plaintiffs,

v.

RICOH COMPANY, LTD.,

Defendant.

AND RELATED COUNTERCLAIMS.

Case No. C07-01942-MHP

**ANSWER TO COMPLAINT AND
COUNTERCLAIMS**

JURY TRIAL DEMANDED

1 Defendant Ricoh Company, Ltd. (“Ricoh”), by and through its undersigned counsel, files
2 this Answer to the Complaint herein by ASUSTeK Computer Inc. and ASUS Computer
3 International (collectively, “ASUSTEK”).

4 INTRODUCTION

5 1. Admitted that this action concerns the validity and infringement of the following
6 four United States Patents that Ricoh owns by assignment: U.S. Patent No. 5,063,552 (“the ’552
7 patent”); U.S. Patent No. 6,172,955 (“the ’955 patent”); U.S. Patent No. 6,631,109 (“the ’109
8 patent”); and U.S. Patent No. 6,661,755 (“the ’755 patent”) (collectively, the “Patents-in-Suit”).

9 2. Admitted, except that the patent infringement complaint filed by Ricoh in the
10 Western District of Wisconsin titled *Ricoh Company Ltd. v. Asustek Computer Inc. et al.*, Civil
11 Action No. 06-C-0462-C (the “Wisconsin Action”), no longer is pending in that court. The court
12 granted summary judgment against Ricoh, which filed a notice of appeal. That appeal is pending
13 in the Federal Circuit.

14 3. Denied.

15 4. Admitted that paragraph 4 of the Complaint sets forth the relief requested by
16 ASUSTEK.

17 THE PARTIES

18 5. Admitted.

19 6. Admitted.

20 7. Admitted.

21 JURISDICTION

22 8. Admitted.

23 9. Denied, except that it is admitted that Ricoh has participated as a party in the past,
24 and is currently a party in other actions that are now pending, in the Northern District of
25 California.

26 VENUE

27 10. Denied with respect to 28 U.S.C. § 1391(b) & (c); admitted with respect to 28
28 U.S.C. § 1391(d).

29 FACTUAL BACKGROUND

30 11. Admitted.

31 12. Admitted.

1 13. Admitted.

2 14. Admitted.

3 15. Admitted.

4 16. Admitted.

5 17. Admitted.

6 18. Admitted that ASUSTEK filed a motion to dismiss the Wisconsin Action on
7 January 18, 2007. Ricoh respectfully directs the Court to the motion in question for a complete
8 and accurate statement of its contents.

9 19. Admitted.

10 **COUNT I**

11 20. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

12 21. Denied.

13 22. Denied.

14 23. Denied, except that Ricoh admits that there exists a controversy between
15 ASUSTEK and Ricoh as to the validity of the '552 patent.

16 24. Denied.

17 **COUNT II**

18 25. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

19 26. Denied.

20 27. Denied.

21 28. Denied, except that Ricoh admits that there exists a controversy between
22 ASUSTEK and Ricoh as to the infringement of the '552 patent.

23 29. Denied.

24 **COUNT III**

25 30. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

26 31. Denied.

27 32. Denied.

28 33. Denied, except that Ricoh admits that there exists a controversy between
ASUSTEK and Ricoh as to the validity of the '955 patent.

34. Denied.

COUNT IV

35. The answers in paragraphs 1-19 are repeated as though set forth in full herein.

36. Denied.

37. Denied.

38. Denied, except that Ricoh admits that there exists a controversy between ASUSTEK and Ricoh as to the infringement of the '955 patent.

39. Denied.

COUNT V

40. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

41. Denied.

42. Denied.

43. Denied, except that Ricoh admits that there exists a controversy between ASUSTEK and Ricoh as to the validity of the '109 patent.

44. Denied.

COUNT VI

45. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

46. Denied.

47. Denied.

48. Denied, except that Ricoh admits that there exists a controversy between ASUSTEK and Ricoh as to the infringement of the '109 patent.

49. Denied.

COUNT VII

50. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

51. Denied.

52. Denied.

53. Denied, except that Ricoh admits that there exists a controversy between ASUSTEK and Ricoh as to the validity of the '755 patent.

54. Denied.

COUNT VIII

55. The responses in paragraphs 1-19 are repeated as though set forth in full herein.

56. Denied.

1 57. Denied.

2 58. Denied, except that Ricoh admits that there exists a controversy between
3 ASUSTEK and Ricoh as to the infringement of the '755 patent.

4 59. Denied.

5 **COUNTERCLAIMS**
6

7 Ricoh complains of ASUSTEK as follows, and demands a jury trial of all issues so
8 triable.

9 **THE PARTIES**

10 60. On information and belief, ASUSTeK Computer Inc. is a Taiwanese company
11 with its principal place of business in Taiwan.

12 61. On information and belief, ASUS Computer International is a California company
13 with its principal place of business in Fremont, California. (Counterclaim Defendants ASUSTeK
14 Computer Inc. and ASUS Computer International will be referred to hereinafter collectively as
15 "ASUSTEK").

16 62. Ricoh Company, Ltd., is a Japanese company with its principal place of business
17 in Japan.

18 **JURISDICTION AND VENUE**

19 63. The present counterclaims for patent infringement arise under the laws of the
20 United States, including 35 U.S.C. § 271. This Court has jurisdiction over these counterclaims
21 under 28 U.S.C. §§ 1331 and 1338(a).

22 64. This Court has personal jurisdiction over ASUSTEK and venue is proper in this
23 judicial district by reason, *inter alia*, of ASUSTEK's instituting the present lawsuit before this
24 Court in this judicial district.

25 **COUNT I – Infringement of the '552 Patent**

26 65. Ricoh realleges and incorporates by reference the allegations of paragraphs 60-64.

27 66. On November 5, 1991, the United States Patent and Trademark Office duly and
28 legally issued to Ricoh U.S. Patent No. 5,063,552 ("the '552 patent"), which Ricoh has owned at
all times since then.

67. AUSTEK has appropriated the invention and sold or offered for sale optical disk

1 drives embodying it. ASUSTEK has been and still is infringing the foregoing patent by doing
2 the following things, among others:

- 3 (a) making or causing to be made optical storage devices that embody the patented
4 system and perform the patented method as part of their normal and intended
5 operation, shipping such devices, or causing them to be shipped, to the United
6 States, and importing such devices, or causing them to be imported, into the
7 United States, in violation of 35 U.S.C. § 271(a);
- 8 (b) offering to sell and selling such devices, or causing them to be offered for sale and
9 sold, in the United States, including, without limitation, in this district, in
10 violation of 35 U.S.C. § 271(a);
- 11 (c) contributing to infringement of the patent by selling such devices, knowing them
12 to be specially adapted for practicing the patented invention and not a staple
13 article or commodity of commerce suitable for substantial noninfringing use, and
14 knowing of the aforesaid patent, in violation of 35 U.S.C. § 271(c);
- 15 (d) actively inducing infringement of the patented system and patented method by
16 knowingly selling such devices, and in advertising and promotional materials
17 knowingly advising and urging customers to use the patented invention, in
18 violation of 35 U.S.C. § 271(b); and
- 19 (e) aiding and abetting other persons to infringe and cause infringement of the patent.

20 68. Such infringement has injured and damaged Ricoh. Unless enjoined by this
21 Court, ASUSTEK will continue its infringement, irreparably injuring Ricoh.

22 69. Ricoh has demanded of ASUSTEK that it pay Ricoh a royalty or else desist from
23 the infringing use of the invention, but ASUSTEK has failed and refused to do either.

24 **COUNT II – Infringement of the '955 Patent**

25 70. Ricoh realleges and incorporates by reference the allegations of paragraphs 60-64.

26 71. On January 9, 2001, the United States Patent and Trademark Office duly and le-
27 gally issued to Ricoh U.S. Patent No. 6,172,955 (“the '955 patent”), which Ricoh has owned at
28 all times since then.

72. ASUSTEK has appropriated the invention and sold or offered for sale optical disk
drives embodying it. ASUSTEK has been and still is infringing the foregoing patent by doing
the following things, among others:

- (a) making or causing to be made optical storage devices that embody the patented system and perform the patented method as part of their normal and intended operation, shipping such devices, or causing them to be shipped, to the United States, and importing such devices, or causing them to be imported, into the United States, in violation of 35 U.S.C. § 271(a);
- (b) offering to sell and selling such devices, or causing them to be offered for sale and sold, in the United States, including, without limitation, in this district, in violation of 35 U.S.C. § 271(a);
- (c) contributing to infringement of the patent by selling such devices, knowing them to be specially adapted for practicing the patented invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, and knowing of the aforesaid patent, in violation of 35 U.S.C. § 271(c);
- (d) actively inducing infringement of the patented system and patented method by knowingly selling such devices, and in advertising and promotional materials knowingly advising and urging customers to use the patented invention, in violation of 35 U.S.C. § 271(b); and
- (e) aiding and abetting other persons to infringe and cause infringement of the patent.

73. Such infringement has injured and damaged Ricoh. Unless enjoined by this Court, ASUSTEK will continue its infringement, irreparably injuring Ricoh.

74. Ricoh has demanded of ASUSTEK that it pay Ricoh a royalty or else desist from the infringing use of the invention, but ASUSTEK has failed and refused to do either.

COUNT III – Infringement of the '109 Patent

75. Ricoh realleges and incorporates by reference the allegations of paragraphs 60-64.

76. On October 7, 2003, the United States Patent and Trademark Office duly and legally issued to Ricoh U.S. Patent No. 6,631,109 (“the '109 patent”), which Ricoh has owned at all times since then.

77. ASUSTEK has appropriated the invention and sold or offered for sale optical disk drives embodying it. ASUSTEK has been and still is infringing the foregoing patent by doing the following things, among others:

- (a) making or causing to be made optical storage devices that embody the patented system and perform the patented method as part of their normal and intended

operation, shipping such devices, or causing them to be shipped, to the United States, and importing such devices, or causing them to be imported, into the United States, in violation of 35 U.S.C. § 271(a);

(b) offering to sell and selling such devices, or causing them to be offered for sale and sold, in the United States, including, without limitation, in this district, in violation of 35 U.S.C. § 271(a);

(c) contributing to infringement of the patent by selling such devices, knowing them to be specially adapted for practicing the patented invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, and knowing of the aforesaid patent, in violation of 35 U.S.C. § 271(c);

(d) actively inducing infringement of the patented system and patented method by knowingly selling such devices, and in advertising and promotional materials knowingly advising and urging customers to use the patented invention, in violation of 35 U.S.C. § 271(b); and

(e) aiding and abetting other persons to infringe and cause infringement of the patent.

78. Such infringement has injured and damaged Ricoh. Unless enjoined by this Court, ASUSTEK will continue its infringement, irreparably injuring Ricoh.

79. Ricoh has demanded of ASUSTEK that it pay Ricoh a royalty or else desist from the infringing use of the invention, but ASUSTEK has failed and refused to do either.

COUNT IV – Infringement of the '755 Patent

80. Ricoh realleges and incorporates by reference the allegations of paragraphs 60-64.

81. On December 9, 2003, the United States Patent and Trademark Office duly and legally issued to Ricoh U.S. Patent 6,661,755 (“the ’755 patent”), which Ricoh has owned at all times since then.

82. ASUSTEK has appropriated the invention and sold or offered for sale optical disk drives embodying it. ASUSTEK has been and still is infringing the foregoing patent by doing the following things, among others:

(a) making or causing to be made optical storage devices that perform the patented method as part of their normal and intended operation, shipping such devices, or causing them to be shipped, to the United States, and importing such devices, or

1 causing them to be imported, into the United States, in violation of 35
2 U.S.C. § 271(a);

3 (b) offering to sell and selling such devices, or causing them to be offered for sale and
4 sold, in the United States, including, without limitation, in this district, in
5 violation of 35 U.S.C. § 271(a);

6 (c) contributing to infringement of the patent by selling such devices, knowing them
7 to be specially adapted for practicing the patented invention and not a staple
8 article or commodity of commerce suitable for substantial noninfringing use, and
9 knowing of the aforesaid patent, in violation of 35 U.S.C. § 271(c);

10 (d) actively inducing infringement of the patented method by knowingly selling such
11 devices, and in advertising and promotional materials knowingly advising and
12 urging customers to use the patented invention, in violation of 35 U.S.C. § 271(b);
13 and

14 (e) aiding and abetting other persons to infringe and cause infringement of the patent.

15 83. Such infringement has injured and damaged Ricoh. Unless enjoined by this
16 Court, ASUSTEK will continue its infringement, irreparably injuring Ricoh.

17 84. Ricoh has demanded of ASUSTEK that it pay Ricoh a royalty or else desist from
18 the infringing use of the invention, but ASUSTEK has failed and refused to do either.

19 **REQUEST FOR RELIEF**

20 WHEREFORE, Ricoh prays that the Court enter judgment ordering as follows:

21 A. adjudicating and declaring that ASUSTEK has infringed, actively induced
22 infringement of, and contributorily infringed the foregoing patents;

23 B. enjoining ASUSTEK from further infringement of the foregoing patents by
24 unauthorized use of the inventions patented therein, by ASUSTEK and its officers, agents,
25 servants, employees, attorneys and all persons in active concert or participation with them;

26 C. that ASUSTEK account, and pay actual damages (but no less than a reasonable
27 royalty), to Ricoh for ASUSTEK's infringement of the foregoing patents;

28 D. that ASUSTEK pay treble damages to Ricoh as provided by 35 U.S.C. § 284;

E. that ASUSTEK pay Ricoh's costs, expenses, and prejudgment interest as provided
for by 35 U.S.C. § 284;

1 F. adjudicating and declaring that this case is exceptional within the meaning of 35
2 U.S.C. § 285 and that Ricoh should be awarded its reasonable attorneys fees; and

3 G. granting Ricoh such other and further relief as the Court deems just and ap-
4 propriate.

5
6 **DEMAND FOR JURY TRIAL**

7 Pursuant to Federal Rule of Civil Procedure 38, Ricoh demands a jury trial on all issues
8 so triable.

9
10 Dated: September 17, 2007

Respectfully submitted,

11 /s/ Donald P. Gagliardi

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